

REMARKS

Claims 1-5 and 7-20 were pending.

Claims 2, 3 and 6-18 are cancelled.

Claims 1, 4-5, 19-20 are now pending.

Claims 1, 4, 5 and 19-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of copending Application No. 09/776,657, now granted patent US 6,399,805 and Application No. 09/856,769.

Double Patenting

Applicants have enclosed a terminal disclaimer under 37 CFR 1.321 to overcome the Examiner's rejection of claims 1, 4, 5 and 19-20 over copending Application No. 09/776,657, now granted patent US 6,399,805.

Examiner asserts a provisional obviousness-type double patenting rejection of the instant claims 1, 4, 5 and 19-20 over pending application 09/856769. Examiner asserts that claim 16 of SN '769 reads on instant claims 1 and 4. Furthermore, she states SN' 769 sets forth a method of reaction which read on the instant claims 5 and 6 (now 19 and 20). The Applicant disagrees with the opinion of the Examiner.

Claim 16 of SN '769 has been cancelled during prosecution of SN '769 in "Response to Restriction Requirement" sent on September 5, 2003.

The compounds according to SN '769 are "symmetrical" compounds. In the case of bisacylphosphine oxide compound, SN '769 shows only identical acyl groups. Note examples 1-12 and 17 of SN '769. All of bisacylphosphine oxide examples 19-21 of the instant application are non-symmetrical. Furthermore, in the present application only "unsymmetrical" compounds are a subject of the claims. See the proviso on page 29 claim 19, line 8 that "Y₁ is not identical with Ar".

In the case of the monoacylphosphine compounds, SN '769 show only non-acyl groups that are identical or symmetrical. Note examples 13-16. There is nothing in the specification of SN '769 to

imply or suggest that the process could be used for forming unsymmetrical acyl phosphine oxides. In order to define obviousness it is not sufficient that the skilled person in the art could have used the process. There must also be a sufficient motivation in said prior art for the skilled person to do so. SN '769 does not make the suggestion in example or disclosure. Therefore, the Applicants respectfully request the examiner to reconsider the double patenting rejection for SN '769.

Reconsideration and withdrawal of the rejection of claims 1, 4-5, 19-20 is respectfully solicited in light of the remarks *supra*.

Since there are no other grounds of objection or rejection, passage of this application to issue with claims 1, 4-5, 19-20 is earnestly solicited.

Applicants submit that the present application is in condition for allowance. In the event that minor amendments will further prosecution, Applicants request that the examiner contact the undersigned representative.

Respectfully submitted,



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